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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,140	11/06/2000	Outi Aho	460-009944-US(PAR)	8800
2512	7590	08/24/2006	EXAMINER	
PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824			VU, THONG H	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/707,140

Applicant(s)

AHO, OUTI

Examiner

Thong H. Vu

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. Claims 1-52 are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-52 have been considered but are moot in view of the new ground(s) of rejection. The new ground(s) of rejection is made in view of Wallentin-Moore-Buckley.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-52 are rejected on the ground of nonstatutory double patenting over claims 1-13 of U. S. Patent No. 6,678,361 B2 ('361) since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

(‘361)7. A method for delivering messages in a communication network consisting of at least one terminal and a multimedia messaging service center, said method comprising the steps of:  
receiving a message for said terminal by said multimedia messaging service center (i.e.: server);

said multimedia messaging service center receiving capability information concerning the capabilities of the terminal from said terminal, the capability information being capable of indicating codecs supported by said terminal;

sending a notification that notifies about the presence of said message from said multimedia messaging service center to said terminal, the notification containing information describing the properties of the message;

deciding by said terminal based on its capabilities, current user profile and the properties of the message provided by the notification how said received message should be handled;

replying by said terminal to the notification sent by said multimedia messaging service center, therewith instructing said multimedia messaging service center according to the result of said decision step; and

handling said message by said multimedia messaging service center according to said instructions.

(Application) 1. A method for implementing a multimedia messaging service between a wireless terminal that communicates with a communication network over a radio path and a server; the method comprising the steps of:

- Receiving and storing a multimedia message addressed to the wireless terminal at the server, said multimedia message comprising at least one multimedia component, said multimedia message comprising at least one multimedia component

- Storing information on at least one property of the wireless terminal in the server, characterized in that the method further comprises determining if there is any component of the multimedia message which the wireless terminal can handle according to the stored information on at least one property of the wireless terminal, wherein if there exists one or more such component, they are selected for transmission and transmitted to the wireless terminal

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13,15-28,31,33-38,41-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallentin et al [Wallentin 6,772,212 B1] in view of Moore et al [Moore, 6,216,013 B1].

4. As per claim 1, Wallentin discloses a method for implementing a multimedia messaging service between a wireless terminal that communicates with a communication network over a radio path and a server [Wallentin, radio channels, multimedia services, Mobile center or server, col 4 lines 10-42] the method comprising the steps of:

Receiving and storing a multimedia message addressed to the wireless terminal at the server, said multimedia message comprising at least one multimedia component, said multimedia message comprising at least one multimedia component [Wallentin, multimedia services, Mobile center or server, col 4 lines 10-42];

Wallentin also taught determining packet parameter to select the different channel types [Wallentin, col 12 lines 22-40]

However Wallentin does not explicitly detail storing information on at least one property of the wireless terminal in the server, characterized in that the method further comprises determining if there is any component of the multimedia message which the wireless terminal can handle according to the stored information on at least one property of the wireless terminal, wherein if there exists one or more such component, they are selected for transmission and transmitted to the wireless terminal.

In the same endeavor, Moore discloses a communication system with handset for distributed processing includes the stored and forward server, a handset determines the type of object being input and its properties which can then be transmitted in coded form to the application [Moore, col 3 lines 29-43; col 9 lines 25-45]

Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate the storing property information and determining type of object and its properties to transmit as taught by Moore into the Wallentin's apparatus in order to utilize the selecting different packet type process. Doing so would provide the best suite for a particular channel type on mobile device.

5. Claims 19,35,43 contain the identical limitations set forth of apparatus claim 1. Therefore, claims 19,35,43 are rejected for the similar rationale set forth in claim 1.

6. As per claims 2,20,44 Wallentin-Moore disclose selecting at least one bearer for transmission of the selected component(s) of the multimedia message [Wallentin, bearer service, col 3 line 5].

7. As per claims 3,21 Wallentin-Moore disclose the selection of at least one bearer is performed in the wireless terminal [Wallentin, bearer service, col 3 line 5].

8. As per claims 5,23 Wallentin-Moore disclose the selection of a component of a multimedia message for transmission is performed in the server [Wallentin, multimedia services, Mobile center or server, col 4 lines 10-42].

9. As per claims 6,24,37,46 Wallentin-Moore disclose information on at least one property of the wireless terminal is changed to prevent or allow the transmission of at least one component of the multimedia message [Moore, full range, col 6 lines 33-56].

10. As per claims 7,25,47 Wallentin-Moore disclose said information on the properties of the wireless terminal comprises information on the available storage capacity of the wireless terminal [Moore, full range, col 6 lines 33-56].

11. As per claims 8,26,48 Wallentin-Moore disclose said information on the properties of the wireless terminal comprises information on the capability of the

wireless terminal to process multimedia components of a particular type [Wallentin, specify a different characteristic, col 5 lines 36-42].

12. As per claims 9,27,49 Wallentin-Moore disclose the capability of the wireless terminal to process multimedia components is defined on the basis of the hardware properties of the wireless terminal and/or the properties of the programs installed in the wireless terminal [Moore, determines the type of object being input and its properties which can then be transmitted in coded form to the application, col 3 lines 29-43; col 9 lines 25-45].

13. As per claims 10,28,38 Wallentin-Moore disclose a maximum time of validity is defined for the information on the properties of the wireless terminal stored in said server [Wallentin, a predetemrind time period, col 7lines 5-22].

14. As per claims 11,50 Wallentin-Moore disclose a multimedia message addressed to the wireless terminal and comprising at least one multimedia component, is received at the server and a notification message is transmitted to the wireless terminal to indicate that a multimedia message has arrived, characterized in that in the method it is examined whether information on the properties of the wireless terminal in question is stored in the server, wherein, if said information is not stored in the server, said notification message is supplemented with a request to update the properties of the wireless terminal, wherein information on the properties of the wireless terminal is



transmitted from the wireless terminal to the server [Wallentin, update type of mobility management scheme, col 7lines 23-52].

15. As per claim 12, Wallentin-Moore disclose examined whether said information on the properties of the wireless terminal stored in the server is valid, wherein if said information is not valid, said notification message is supplemented with a request to update the properties of the wireless terminal [Wallentin, notification message, col 8lines 61-67].

16. As per claims 13,31 Wallentin-Moore disclose said property information stored in the server is used as the property information of the wireless terminal if the sever does not receive a reply from the wireless terminal to said property update request [Wallentin, update type of mobility management scheme, col 7lines 23-52].

17. As per claims 15,33,42 Wallentin-Moore disclose a WAP terminal is used as a wireless terminal and that a multimedia message service centre (MMSC) is used as a server [Wallentin, multimedia services, Mobile center or server, col 4 lines 10-42].

18. As per claims 16,34,52 Wallentin-Moore disclose a connection set-up request is transmitted from the wireless terminal to set up a connection for the transmission of at least one multimedia component of a multimedia message addressed to said wireless terminal, characterized in that the connection set-up message used is a Uaprof

information transmission message according to WAP specifications (i.e.: property), and that the header field is supplemented with a profile-diff header field, if the connection set-up message is supplemented with information on the properties of the wireless terminal, or the header field is supplemented with a profile header field if the connection set-up message is not supplemented with information on the properties of the wireless terminal [see claim 1 rejection].

19. As per claim 17, Wallentin-Moore disclose those components of the multimedia message specified in the property information of the receiving wireless terminal stored in the multimedia messaging system are transmitted without a transmission request being transmitted from the wireless terminal [Wallentin, multimedia services, col 4 lines 10-42]

20. As per claims 18,41 Wallentin-Moore disclose a transmission request is transmitted from the wireless terminal to transmit such multimedia message components which have *not* been specified in the property information of the receiving wireless terminal stored in the multimedia messaging system [Wallentin, multimedia services, col 4 lines 10-42].

21. As per claim 51, Wallentin-Moore disclose the wireless terminal is a WAP terminal or mobile node [Wallentin, Mobile center or server, col 4 lines 10-42].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4,14,22,29,32,30,36,39,40,45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallentin et al [Wallentin 6,772,212 B1] in view of Moore et al [Moore, 6,216,013 B1] and further in view of Buckley [6,163,809].

22. As per claims 4,14,22,29,32,30,36,39,40,45 Wallentin-Moore disclose a method for implementing a multimedia messaging service between a wireless terminal that communicates with a communication network over a radio path and a server

However Wallentin does not explicitly detail the notification message with at least one property of said multimedia component.

In the same endeavor, Buckley discloses a notification information with one or more properties that are carried along as part of message [Buckley, col 14 lines 43-59]

Therefore it would have been obvious to an ordinary skill in the art at the time the invention was made to incorporate the notification process between the mobile devices and server with the property of a multimedia component as taught by Buckley into the Wallentin-Moore apparatus in order to utilize the notification process. Doing would provide a high quality dynamically multimedia information specifically suited to the target users.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner *Thong Vu*, whose telephone number is (571)-272-3904. The examiner can normally be reached on Monday-Thursday from 6:00AM- 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Andrew Caldwell*, can be reached at (571) 272-3868. The fax number for the organization where this application or proceeding is assigned is 571-273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval IPAIRI system. Status information for published applications may be obtained from either Private PMR or Public PMR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Thong Vu*  
*Primary Examiner*  
*Art Unit 2142*

A handwritten signature in black ink, appearing to read 'Thong Vu', with a horizontal line underneath.